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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,219	09/14/2006	Werner Brandstatter	335.0112	3718
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Setter Roche LLP				
P.O. Box 780				
Eric, CO 80516				
EXAMINER				
NGUYEN, DONGHAID				
ART UNIT		PAPER NUMBER		
3729				
NOTIFICATION DATE		DELIVERY MODE		
04/29/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/566,219

Applicant(s)

BRANDSTATTER ET AL.

Examiner

DONGHAI D. NGUYEN

Art Unit

3729

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-29 is/are pending in the application.
- 4a) Of the above claim(s) 21-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2011 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed on February 10, 2011 has been considered and entered. Claims 1 and 3-19 are pending. Claims 21-29 are withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 3-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

“any required” (claim 1, lines 5-7) is vague and indefinite because it is uncertain as to whether the limitation following the phrase are required or not.

“element(s)” (claim 1, line 10), “at most” and “at least” (claim 8, lines 2-3); “up to” (claim 16, line 2) are vague and indefinite since the resulting claim does not set forth the metes and bounds of the claimed invention because it's uncertain as to what is the range of ratio of Zinc and the range of time above the austenizing temperature applicants referred to since there is upper or lower limit being set in the claimed invention and how many elements are there.

“its surface” (claim 1, line 10) should be changed to: --a surface of the steel sheet--.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1, 3-9, 14 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,566,604 to Kefferstein et al.

Regarding claim 1, Kefferstein et al disclose a method for producing hardened structural parts from sheet steel, comprising: shaping at least one shaped part made of sheet steel (see Col. 1, lines 56-57) provided with a cathodic corrosion protection coating (see Col. 1, lines 59-64), wherein the cathodic corrosion protection coating is applied using a hot-dip galvanizing, where the coating is a mixture comprising zinc, and the mixture contains at least one element of magnesium and/or silicon and/or titanium and/or calcium and/or aluminum with affinity to oxygen in a total amount of 0.1- 15% wt in relation to the entire coating (see Col. 3, lines 54-65), and wherein in the course of heating the sheet steel to the temperature required for hardening, a skin of an oxide of the element(s) with affinity to oxygen is formed on its surface; performing any required final trim of the shaped part and possibly any required punching, or the creation of a perforation pattern, prior to, during or after shaping of the shaped part (this step is optional and not performing when no final trim, punching or pattering is required); heating the shaped part, at least over partial areas, under the admission of atmospheric oxygen to a temperature which permits austenizing of the steel material (see Col. 2, lines 20-22) subsequently to any required final trim, any required punching, and/or the creation of a perforation pattern of the shaped part;

and thereafter transferring the structural part to a mold-hardening tool and performing mold-hardening in the mold-hardening tool, wherein the structural part is cooled by the contact with and pressing by the mold-hardening tool and is hardened thereby (see Fig. 2 see Col. 2, lines 63-65).

Regarding claims 3-9, Kefferstein et al disclose the magnesium and/or silicon and/or titanium and/or calcium and/or aluminum with affinity to oxygen in a total amount of 0.1- 5% wt in relation to the entire coating (see Col. 3, lines 54-65), and the coating having at least two phases of a zinc-rich and an iron-rich phase, wherein the iron-rich phase is formed at a ratio of zinc to iron of at most 0.95 (Zn/Fe 0.95), and the zinc-rich phase at a ratio of zinc to iron of at least 2.0 (Zn/Fe > 2.0) and, wherein the iron- rich phase has a ratio of zinc to iron of approximately 30:70, and the zinc-rich phase has a ratio of zinc to iron of approximately 80:20 (inherent, Kefferstein et al disclose the same materials and process as claimed therefore the same results are expected).

Regarding claim 14, Kefferstein et al disclose the cathodic corrosion-protection coating having a constant thickness over the structural part as (see Figs. 1-2).

Regarding claim 20, Kefferstein et al disclose pressing and hardening the shaped part with the molding tool halves substantially simultaneously over the full surface and with the same force (see Figs. 1-2).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10-13, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kefferstein et al in view of EP 1,439,240 to Imai et al.

Kefferstein et al do not disclose the coating contains individual areas with zinc proportions > 90% zinc and at an initial thickness of 15 micrometer, the coating has a cathodic protection effect of at least 4 J/cm² after the hardening process and a liquid metal bath at a temperature of 425°C to 690°C or 440°C to 495°C with subsequent cooling of the coated sheet, wherein the time above the austenizing temperature at 780 to 950°C is up to 10 minutes. Imai et al teach the above limitations (see paragraphs 76 and Table 15 of Imai) for forming a steel material having high tensile corrosion resistance. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Kefferstein et al by utilizing the process of coating the steel as taught by Imai et al for forming a steel material having high tensile corrosion resistance (see Abstract).

8. Claims 15, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kefferstein et al.

It would have been an obvious matter of design choice to one having ordinary skill in the art at the time the invention was made to choose any size for the shaped part such that the final shaped part having a desired shape, since it has been held that where the general conditions of a claim are disclosed (i.e. shaping, trimming and heat treatment the steel sheet) in the prior art,

discovering the optimum or workable ranges (i.e., size of shaped part) involves only routine skill in the art.

Response to Arguments

9. Applicant's arguments filed on February 10, 2011 have been fully considered but they are not persuasive. Applicants argue that "The Kefferstein reference fails to disclose the formation of hardened structural parts have cathodic corrosion protection" (see "Remarks" page 11, 4th paragraph). The Examiner disagrees because Kefferstein et al disclose all method steps and structural elements as currently claim by the claimed invention therefore the same result (i.e. formation of hardened structural parts have cathodic corrosion protection) is expected.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DONGHAI D. NGUYEN whose telephone number is (571)272-4566. The examiner can normally be reached on Monday-Friday (9:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on (571)-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DN
April 25, 2011

/Donghai D. Nguyen/
Primary Examiner, Art Unit 3729